

Application No. 10/775,171
Amendment Dated: November 19, 2008
Reply to Office Action of: October 7, 2008

REMARKS/ARGUMENTS

Applicant has amended independent claims 25 and 31, dependent claims 29 and 30 which depend on claim 25, and dependent claims 35 and 36 which depend on claim 31.

Upon entry of the amendment, claims 2-7, 16-19, and 25-36 are pending for reconsideration. Claims 1 and 13 are canceled. Claims 8-12, 14, 15 and 20-24 are withdrawn from consideration.

Claim Rejections 35 U.S.C. §112:

Claims 2-7 and 25-30 were rejected under 35 U.S.C. §112 second paragraph as being indefinite for failing to particularly point out and distinctly claim subject matter which applicant regards as the invention.

Applicant has amended the independent claims 25 and 31 to provide antecedent basis and to remove reference to "will likewise" and "the remaining ones".

Applicant respectfully submits that all claims as amended satisfy 35 U.S.C. §112.

Claim Rejections 35 U.S.C. §103:

Claims 25-30, 2-7, 16-19 and 31-36 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,382,353 to Kelly in view of U.S. Patent No. 4,787,188 to Murphy.

Applicant respectfully traverses the Examiner's rejection for obviousness over the Kelly reference in view of the Murphy reference.

The Examiner's attention is respectfully directed to independent claim 25 which states "said seam plates being affixed to said substrate independently of the fasteners" and the additional feature that "said plurality of seam plates are disposed ...at predeterminedly spaced positions along said longitudinal extent of said substrate so as to define with said substrate an integral product entity such that when said first seam plate of said plurality of seam plates is fixedly secured at a first location along the underlying roof decking substructure by means of a fastener, the remaining seam plates of said plurality of seam plates, fixedly attached to said substrate at predetermined positions along the longitudinal extent of the said substrate, will inherently be disposed at pre-determined locations along the underlying roof decking substructure"...

It is respectfully submitted that even if the Kelly/Murphy combination were proper, the proposed combination simply does not disclose, teach or suggest either of the two noted features. Applicants' invention, which represents a marked departure from the related prior art assemblies, employs seam plates which are pre-mounted to the substrate at pre-determined positions. The seam plates are affixed to the substrate without the use of fasteners. Once the fastener affixes a substrate to the underlying roof decking substructure, the pre-mounted plates at the pre-determined positions fixedly secured by fasteners automatically ensure the proper fixation of the seam plates to the underlying roof

decking substructure. The Examiner will appreciate that this is a significant technical departure from the prior art which would require serial individual seam plate placement and serial fastening to obtain the proper fixation of the membranes upon the underlying roof decking substrate.

The Examiner explicitly acknowledges (page 4 of the Action) that Kelly..."does not expressly disclose the assembly comprises a plurality of seam plates are to be fixedly secured by the fasteners so as to ensure the proper fixation of said seam plates to the underlying roof decking substructure whereby, in turn, a fixation of the environmental membranes upon the underlying roof decking substructure, will likewise be ensured" (the quoted language is now not identical with that of the amended claim but the deficiency of Kelly is relevant). Murphy is cited for disclosing seam plates having an opening for receiving the appropriate fastening means such as screws. However, nowhere does the Examiner identify a disclosure in Murphy, and in fact there is none, which allows the proper fixation of the seam plates to the underlying roof decking. Nor is there any discussion, nor disclosure whatsoever in either Kelly or Murphy for the feature that the seam plates are affixed to the substrate independently of the fasteners.

Independent claim 31 also recites the feature of the "seam plates being affixed to said substrate independently of the fastener" and the feature wherein "said plurality of seam plates are disposed...at predeterminedly spaced positions spaced along said longitudinal extent of said at least one substrate, so as to

define with said at least one substrate an integral product entity such that when said first said seam plate of said plurality of seam plates is fixedly secured at a first location along said underlying roof decking substructure by means of a fastener, the remaining seam plates of said plurality of seam plates, fixedly attached to said at least one substrate at said predetermined positions spaced along said longitudinal extent of said at least one substrate, will inherently be disposed at predetermined locations along said underlying roof decking substructure..." Again (at page 8) the Examiner acknowledges "Kelly does not expressly disclose the assembly comprises a plurality of seam plates are to be fixedly secured by the fasteners so as to ensure proper fixation of said seam plates to the underlying roof decking substructure whereby, in turn the fixation of the environmental membranes upon the underlying decking substructure, will likewise be ensured" (the quoted language is now not identical with that of the amended claim but the deficiency of Kelly is relevant).

Once again, it is not enough that Murphy discloses seam plates. It is very clear that neither Murphy nor Kelly disclose the features wherein the seam plates are fixed to the substrate independently of the fasteners and the predetermined positions of the seam plates so that they will inherently be disposed at predetermined locations along the underlying roof decking substructure. Nor does the Examiner establish any basis as to why such a feature would be obvious to one skilled in the art.

Claims 2-7 and 20-30, which depend directly or indirectly on independent claim 25, are patentable for at least the reasons advanced for claim 25.

In addition, claim 4 is patentable for the reasons that none of the references including the proposed combination of Kelly and Murphy disclose the “substantially C-shaped cross-sectional configuration comprising an upper planar membrane disposed atop the plurality of seam plates, and a pair of lower planar flap-type members folded inwardly from opposite side edge portions of said upper planar member”. This feature is provided, in part, so that the flap-type members only partially cover under surface portions of each one of the plurality of seam plates to enable them to freely engage the environmental member (as, for example, explicitly described in claim 6). Consequently, it is not seen how there is any proper basis for obviousness rejections for the features of claims 4-7. In this regard, applicant respectfully traverses the Examiner’s conclusion that the C-shaped cross-sectional configuration would be a matter of obvious design choice to one of ordinary skill in the art.

Applicant respectfully further submits that claims 16-19 and 32 -36 which depend directly or indirectly on independent claim 31, are patentable for at least the reasons advanced for independent claim 31.

In addition, claims 16, 18 and 19 are patentable for the reasons previously set forth in this respect for dependent claims 4, 6, and 7.

The Examiner has also rejected claims 29-30 and claims 35-36 on the basis of Kelly in view of Murphy, as well as the Examiner’s assertion that

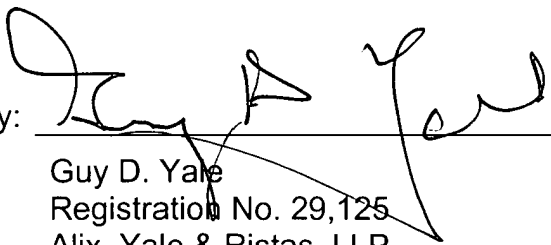
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"fabricated" would have been considered not germane to the issue of patentability. In this regard, it is believed that the Examiner did not consider all the amendments set forth in the Response to Notice of Non-Compliant Amendment filed on January 4, 2008 wherein "fabricated" was deleted from claims 30, 35 and 36. Nevertheless, Applicant in this response has amended the claims further to clarify the claims.

For the foregoing reasons, it is respectfully submitted that all claims in the application, as amended, are in condition for allowance. Accordingly, favorable re-consideration by the Examiner is respectfully submitted.

Respectfully Submitted,

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